

REMARKS

Claims 1-23 are all the claims pending in the application. By this Amendment, Applicant adds claim 23. Claim 23 is clearly supported by the originally filed specification at page 17, Table 1 and page 20, Table 2, for example.

I. Summary of the Office Action

Applicant thanks the Examiner for entering all of the amendments to the claims. In addition, Applicant thanks the Examiner for withdrawing the previous rejections of claims 1-18 under 35 U.S.C. § 112, second paragraph, claims 1, 2, 7-10, 13-16, and 19-22 under 35 U.S.C. § 102(b) and claims 3-6, 11-12, and 17-18 under 35 U.S.C. § 103(a).

However, the Examiner issued new rejections. Specifically, claims 1, 3, 5, 11, and 17 stand rejected under 35 U.S.C. § 112, second paragraph, and claims 1, 7-10, 19, and 21 still stand rejected under 35 U.S.C. § 102(b) as being anticipated by USP 4,376,816 to Hayashi et al. (hereinafter “Hayashi”). Moreover, claims 2, 13-16, 20, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 6,130,023 to Coppens et al. (hereinafter “Coppens”) in view of Hayashi.

Furthermore, claims 3 and 11 still stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi in view of USP 6,306,254 to Usui (hereinafter “Usui 1”) and JP abstract 03036545 to Goto et al. (hereinafter “Goto”), whereas claims 4 and 12 still stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi in view of JP 8-39958 to Usui et al. (hereinafter “Usui 2”) and further in view of USP 5,729,962 to Dirx (hereinafter “Dirx”). Finally, claims 5 and 17 are now rejected under 35 U.S.C. § 103(a) as being

unpatentable over Coppens in view of Hayashi, Usui 1 and Goto, whereas claims 6 and 18 now stand rejected under 35 U.S.C. 103(a) as being unpatentable over Coppens in view of Hayashi and Usui 2.

II. Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 1, 3, 5, 11 and 17 under § 112, 2nd paragraph, as indefinite. Specifically, claim 1 is rejected for insufficient antecedent basis and claims 3, 5, 11, and 17 for not including the nature of the “moisture” property.

With respect to claims 1, 3, 5, 11, and 17, Applicant respectfully requests the Examiner to withdraw this rejection in view of the self-explanatory claim amendments being made herein. Specifically, claim 1 is now amended to recite “an opposing surface” as opposed to “the opposing surface”. With respect to claims 3, 5, 11, and 17, Applicant replaces the term “moisture” with “relative humidity”. These amendments are made solely for the purpose of improved clarity. Since such amendments are made to correct minor, basic elements, Applicant respectfully submits that that they do not narrow the scope of the claim and do not raise any Festo implications.

III. Claim Rejections - 35 U.S.C. § 102(b)

The Examiner rejected claims 1, 7-10, 19, and 21 under §102(b) as being anticipated by Hayashi. Specifically, the Examiner asserts that Hayashi teaches a packaging material with both surfaces having a Bekk smoothness of 5 to 10,000 seconds, which overlaps the claimed range of 3 to 55 seconds. Applicant respectfully submits that Hayashi fails to disclose, teach or suggest a sheet material with different ranges of Bekk smoothness for each surface, as set forth in the

Applicant's amended independent claims 1 and 7. This feature is supported by the originally filed specification at page 17, Table 1 and page 20, Table 2, for example.

Instead, Hayashi teaches that his paper for storing photothermographic plates has a Bekk smoothness of 5 to 10,000 seconds or that it has "smooth surfaces".¹ In short, Hayashi fails to teach or suggest a sheet of material where a contacting surface has a Bekk smoothness range different from the Bekk smoothness range of the non-contacting surface. Accordingly, Hayashi fails to teach or suggest all the elements as set forth in Applicant's independent claims 1 and 7. Therefore, Applicant respectfully requests the Examiner to reconsider and to withdraw this rejection of independent claims 1 and 7. In addition, claims 8-10, 19 and 21 are patentable at least by virtue of their dependency on claims 1 or 7.

IV. Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 2-6, 11-18, 20, and 22 under 35 U.S.C. § 103(a). Applicant respectfully traverses this rejection in view of the following comments.

Claims 2, 13-16, 20 and 22

Claims 2, 13-16, 20, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens in view of Hayashi. Of these claims only claim 2 and 13 are independent.

With respect to claim 2, it recites a number of novel features not found in the prior art. For example, claim 2 recites at least one planographic printing plate comprising an aluminum

¹ Hayashi at col. 2, lines 55-60 and col. 8, line 38.

substrate. The Examiner asserts that Coppens teaches a planographic printing plate as set forth in claim 2. Applicant respectfully disagree. Applicant has carefully studied Coppens lithographic printing plates and Hayashi's photothermographic printing plates which are not similar to the planographic printing plate as set forth in claim 2.

Coppens only teaches a method for making lithographic printing plates according to a silver salt diffusion transfer process. However, there is no relationship between Coppens's technical field and the technical field of the present invention or the technical field of Hayashi.

Hayashi, on the other hand, teaches a method for storing sheets of photothermographic film material using a smooth sheet intervening between the films. An index to evaluate storage capability of such sheets is sensitivity. However, in Hayashi, the object to be stored is not the printing plates as set forth in claim 2, but is the photothermographic sheet material. Moreover, Hayashi fails to account for features which are important in storing the printing plates. For example, Hayashi fails to address the separability of the protection sheet from the surface of the printing plate or the damage that may be caused to an image forming surface of the printing plate. In short, both references fail to teach or suggest a photothermographic plate as set forth in claim 2.

Moreover, there is no motivation for combining the references in a manner suggested by the Examiner. Coppens teaches a method of making a lithographic printing plate, whereas Hayashi teaches a method of storing a photothermographic sheet material. The field of endeavor for these two references are different. Moreover, one of ordinary skill in the art confronted with a problem of packaging printing plates would never have turned to a reference like Coppens,

which deals with a method of making lithographic plates. Therefore, Applicant respectfully requests the Examiner to reconsider and to withdraw this rejection of independent claims 2 and its dependent claim 20.

Claim 13, contains features similar to the features argued above with respect to claim 2, namely at least one planographic printing plate comprising an aluminum substrate. Therefore, arguments presented with respect to claim 2 are submitted to apply with equal force herein. In addition, claim 13 as now amended recites a density range of 0.7 to 0.85 g/cm³. Both Coppens and Hayashi fail to teach or suggest such a density range. Therefore, for at least these reasons, Applicant respectfully submits that independent claim 13, as now amended, is patentable over Coppens in view of Hayashi. Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 13. Moreover, claims 14-16 and 22 are patentable at least by virtue of their dependency on claim 13.

Claims 3 and 11

Furthermore, claims 3 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi in view of Usui 1 and Goto. The Examiner asserts that one of ordinary skill in the art would have been motivated to combine Hayashi with Usui 1 in order to protect the printing plates and to provide stabilization of the sensitivity of the printing plates in a short period of time. In addition, the Examiner asserts that one of ordinary skill in the art would have been motivated to combine Hayashi with Goto in order to prevent deterioration in visible image formability during packing and storing (see pages 11 and 12 of the Office Action).

Applicant respectfully disagrees with the Examiner, and traverses the rejection in view of the following comments. To begin, claims 3 and 11 depend upon claims 1 and 7, respectively. Applicant has already demonstrated that Hayashi does not meet all the requirements of independent claims 1 and 7. Both, Usui 1 and Goto fail to cure the deficient teachings of Hayashi because neither one teaches a sheet of material where contacting surface has a Bekk smoothness range different from the Bekk smoothness range of the non-contacting surface.

In addition, there is no motivation for combining the three references in the manner suggested by the Examiner. Usui 1 deals with a problem of preferable air permeability for stabilizing sensitivity of a printing plate quickly. This reference has nothing to do with protecting photothermographic sheets for a prolonged storage (col. 1, lines 34 to 42). One of ordinary skill in the art, confronted with a problem of prolonged storage, for example for a period of about two years, would never have turned to a reference which stabilizes sensitivity of the printing plates quickly. In short, one of ordinary skill in the art would not have combined the references in the manner suggested by the Examiner. For at least the above reasons, Hayashi, Usui 1 and Goto fail to render obvious claims 3 and 11.

Claims 4 and 12

Claims 4 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi in view of Dirx and further in view of Usui 2. Claims 4 and 12 depend upon claims 1 and 7, respectively. Applicant has already demonstrated that Hayashi does not meet all the requirements of independent claims 1 and 7. Both Dirx and Usui 2 fail to cure the deficient teachings of Hayashi because neither one teaches a sheet of material where contacting surface

has a Bekk smoothness range different from the Bekk smoothness range of the non-contacting surface. As such, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claims 1 and 7. Since claims 4 and 12 are dependent upon claims 1 and 7, respectively, they are patentable at least by virtue of their dependency.

Claims 5 and 17

Claims 5 and 17 are now rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens in view of Hayashi, Usui 1 and Goto. Because this rejection is based on Coppens and Hayashi, arguments with respect to claims 2, 13-16, 20 and 22 are pertinent here as well. Further, because this rejection is also based on the Examiner's attempted combination of Hayashi, Usui 1 and Goto, arguments that there is no motivation to combine these references as set forth above with respect to claims 3 and 11 are applied with equal force herein.

Moreover, Coppens teaches planographic plates, Hayashi teaches packaging for photothermographic plates, Usui 1 and Goto teach packaging for photosensitive plates. These plates are not identical and, as such, require packaging materials with different characteristics. The Examiner does not point out why the properties (e.g. density and relative humidity) acceptable for photothermographic plates are also acceptable or desired characteristic for the packaging material of the planographic plates.

For example, both Hayashi and Coppens address the smoothness, base weight, and pH for the packaging material of the photothermographic sheet, but fail to address the density and relative humidity characteristics of this packaging material for photothermographic sheets. Both

Hayashi and Coppens fail to discuss the density or relative humidity of these packaging sheets because these characteristics are not important in packaging the photothermographic sheet. In contrast, planographic sheets are vulnerable to moisture and density, thereby making these two characteristics very important for its packaging material. In short, different characteristics are important in packaging the photothermographic plates as opposed to planographic plates. Therefore, the packaging material for photothermographic plates and planographic plates should be different. For at least the above reasons, Coppens, Hayashi, Usui 1 and Goto fail to render obvious claims 5 and 17.

Claims 6 and 18

Finally, claims 6 and 18 now stand rejected under 35 U.S.C. 103(a) as being unpatentable over Coppens in view of Hayashi and Usui 2. Claims 6 and 18 depend upon claims 2 and 13, respectively. Applicant has already demonstrated that Hayashi and Coppens do not meet all the requirements of independent claims 2 and 13. Usui 2 fails to cure the deficient teachings of Hayashi and Coppens at least because it does not teach at least one planographic printing plate comprising an aluminum substrate. Moreover, there is no motivation for combining the references. Usui's density is irrelevant for the packaging material of Hayashi and Coppens (both deal with a different type of printing plate). Therefore, one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner. For at least the above cited reasons, Coppens, Hayashi and Usui 2 fail to render obvious claims 6 and 18.

V. New Claim

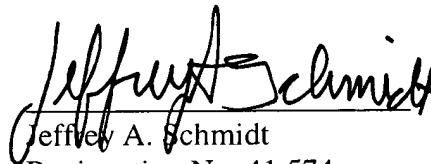
In order to provide more varied protection, Applicant adds claim 23. Claim 23 is patentable over the prior art cited by the Examiner at least for having an opposing surface with a different Bekk smoothness from that of the contacting surface.

VI. Conclusion and request for telephone interview.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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CUSTOMER NUMBER

Date: January 23, 2004